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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/978,525

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Lars Silen

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04/23/2004

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EXAMINER

PHAN, HUY Q

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,526

Applicant(s)

SILEN ET AL.

Examiner

Huy Q Phan

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because in figures 1 and 3, boxes 3, 6, 7, 9, 12 and 14 are not descriptively labeled. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 9, 12, 13, 17, 21, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Pope (US-5,963,624).

Regarding claim 1, Pope discloses in figure 1, a method of controlling an external device, comprising the steps of: sending a control request from a terminal (10) to a telecommunications network (12) (fig. 5, step 106); converting the request into a control

code (fig. 5, step 110 or 112); and sending the control code from the telecommunications network to the external device (14-22) (col. 5, lines 15-39).

Regarding claim 8, Pope discloses a method as recited in the rejection of claim 1, wherein the external device (14-22) being remote from the terminal (10).

Regarding claim 9, Pope discloses a method as recited in the rejection of claim 8, wherein the external device comprises a telecommunications receiver (col. 4, lines 1-15).

Regarding claim 12, Pope discloses a method as recited in the rejection of claim 1, in which the telecommunications network interacts with the terminal to select one of a plurality of predetermined control codes for sending to the external device (col. 2, lines 45-60).

Regarding claim 13, Pope discloses a method as recited in the rejection of claim 12, in which the interaction being at least partly via a speech channel (col. 2, lines 45-60).

Regarding claim 17, Pope discloses in figure 1, a telecommunications network (12) comprising means for converting a control request from a terminal (10) to a control

code and means for sending the control code (fig. 5, step 110 or 112) to an external device (14-22) for controlling the external device (col. 5, lines 15-39).

Regarding claim 21, Pope discloses a telecommunication network as recited in the rejection of claim 17, comprising means for interacting with the terminal to select one of a plurality of predetermined control codes for sending to the external device (col. 2, lines 45-60).

Regarding claim 22, Pope discloses a telecommunication network as recited in the rejection of claim 21, in which the interacting means is arranged to interact with the terminal at least partly via a speech channel (col. 2, lines 45-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 10, 14-16, 18, 19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of Nakano (US-6,639,941).

Regarding claim 2, Pope discloses a method as recited in the rejection of claim 1. Pope fails to expressly show wherein the terminal being a mobile wireless terminal. However in analogous art, Nakano teaches in figure 3 the terminal (3a) being a mobile

wireless terminal (col. 16, lines 20-25). Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having the terminal being a mobile wireless terminal as taught by Nakano for purpose of enhancing the system.

Regarding claim 3, Pope and Nakano disclose a method as recited in the rejection of claim 2. Nakano further discloses in figure 9, wherein the control request being sent from the terminal (3a) to the telecommunications network (2a) using a text messaging service (fig. 5A and col. 15, lines 15-65).

Regarding claim 4, Pope discloses a method as recited in the rejection of claim 1. Pope fails to expressly show wherein the control code being sent from the telecommunications network to the external device using a text messaging service. However, Nakano teaches wherein the control code being sent from the telecommunications network to the external device using a text messaging service (col. 9, lines 25-65). Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically wherein the control code being sent from the telecommunications network to the external device using a text messaging service as taught by Nakano for purpose of providing external device of capability receiving the text message.

Regarding claim 5, Pope discloses a method as recited in the rejection of claim 1. Pope does not particular disclose wherein the external device being associated with or forms part of the terminal. However, Nakano discloses wherein the external device being associated with or forms part of the terminal (col. 15, lines 1-5). Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having the external device being associated with or forms part of the terminal as taught by Nakano in order to control the external device by most convenient and secured technique.

Regarding claim 6, Pope and Nakano disclose a method as recited in the rejection of claim 5. Nakano further discloses in figure 11 wherein the terminal (3a) being coupled to the external device (25) via a local wireless link.

Regarding claim 7, Pope and Nakano disclose a method as recited in the rejections of claims 5 or 6. Nakano further discloses in figure 11 wherein the control code being delivered to the external device (25) via said terminal (3A) (col. 14, lines 30-33).

Regarding claim 10, Pope and Nakano disclose a method as recited in the rejection of claim 3. Nakano further discloses wherein the external device comprises a

telecommunications receiver (3a-8a) and the telecommunications receiver receives a text message containing said control code (col. 9, lines 25-64 and fig. 5A).

Regarding claim 14, Pope discloses a method as recited in the rejection of claim 1. Pope fails to explicitly disclose in response to receipt of the control code, the external device sending a response comprising at least part of a text message to the telecommunications network. However, Nakano recites in response to receipt of the control code, the external device sending a response comprising at least part of a text message to the telecommunications network (col. 15, lines 24-27). Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically in response to receipt of the control code, the external device sending a response comprising at least part of a text message to the telecommunications network as taught by Nakano in order to control the external device by most secured and reliable technique.

Regarding claim 15, Pope and Nakano disclose a method as recited in the rejection of claim 14. Nakano further discloses in which the telecommunications network sending at least part of the response as at least part of a further text message to the terminal (col. 9, lines 26-60).

Regarding claim 16, Pope discloses a method as recited in the rejection of claim

1. Pope does not expressly show a telecommunications network for performing a method as claimed in claim 1. However, Nakano discloses in figure 2, a telecommunications network for performing a method as claimed in claim 1. Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having a telecommunications network for performing a method as claimed in claim 1 as taught by Nakano in order to control the external device by most beneficial system.

Regarding claim 18, Pope discloses a method as recited in the rejection of claim 17. Pope fails to particularly show in which the control request including an identifier identifying the terminal. However, Nakano discloses the control request including an identifier identifying the terminal (col. 9, line 33). Since, Pope and Nakano are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having the control request including an identifier identifying the terminal as taught by Nakano in order to control the external device by most secured and reliable method.

Regarding claim 19, Pope and Nakano disclose a method as recited in the rejection of claim 18. Nakano further discloses, in which the sending means being arranged to send the control code to a destination determined by the identifier (col. 9,

lines 31-37).

Regarding claim 23, Pope and Nakano disclose a telecommunications network as recited in the rejection of claims 16 or 17. Nakano further discloses the network comprising a computer (col. 14, lines 33-35).

Regarding claim 24, Pope and Nakano disclose a telecommunications network as recited in the rejection of claim 23. Pope and Nakano fail to explicitly teach a program for controlling a computer of a network as claimed in claim 23 to perform a method as claimed in claim 1. However it is known in the art to use a program for controlling a computer of a telecommunications network. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having a program for controlling a computer of a network as claimed in claim 23 to perform a method as claimed in claim 1 for purpose of improving the method of controlling the external device in order to increase the quality and reliability of the system.

Regarding claim 25, Pope and Nakano disclose a telecommunications network as recited in the rejection of claim 24. Nakano further discloses a medium (col. 14, lines 34-35) containing a program as claimed in claim 24.

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope in view of Zicker (US-5,247,564).

Regarding claim 11, Pope discloses a method as recited in the rejection of claim 1. Pope does not expressly disclose in which the step of sending a control request to the telecommunications network comprises calling a service telephone number. However in analogous art, Zicker teaches in figure 1 the step of sending a control request to the telecommunications network (18) comprises calling a service telephone number (28b) (col. 3, lines 33-45). Since, Pope and Zicker are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having the step of sending a control request to the telecommunications network comprises calling a service telephone number as taught by Zicker in order to control the external device in case where the type of terminal can not send the text message.

Regarding claim 20, Pope discloses a method as recited in the rejection of claim 17 in which the control code being predetermined (col. 2, lines 50-51). But Pope fails to show the sending means being arranged to send the control code in response to receipt of the service number. However, Zicker recites the sending means being arranged to send the control code in response to receipt of the service number (28b) (col. 3, lines 33-45). Since, Pope and Zicker are related to the method of controlling an external; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Pope by specifically having the sending

means being arranged to send the control code in response to receipt of the service number as taught by Zicker in order to control the external device in case where the type of terminal can not send the text message.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Berstis et al. (US-6,650,894) disclose method of controlling external device.
- b) Vogel (US-6,476,727) discloses long distance remote control.
- c) Yasuoka et al. (US-4,885,766) disclose remote control device.
- d) Winbladh (US-6,205,330) discloses a modified SMS message.
- e) Schulttheiss (US-6,195,548) discloses a unified television/personal computer wireless remote control.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 703-305-9007. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Urban F Edward can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP
Mar. 24, 2004

Quochien B. Vuong 4/19/04

QUOCHIEN B. VUONG
PRIMARY EXAMINER